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09/701,468	11/29/2000	Sadao Kanbe	107289	9973

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EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 07/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

701468

Applicant(s)

KANBE

Examiner

P. TUCKER

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1 - 35 is/are pending in the application.
- Of the above claim(s) 19 - 35 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1 - 12, 14 - 18 is/are rejected.
- ☒ Claim(s) 13 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some\* ☐ None of the:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of the restriction between groups I and II in Paper No. 7 is acknowledged. The traversal is on the ground(s) that a single search could be made for both groups. This is not found persuasive because the scope of search for group I is far broader than that of group II which method of film manufacturing is only overlaps as a tiny subset of the abundant search for both Groups. The search of both inventions would be an enormous burden to the patent office, and thus the requirement is maintained.

The requirement is still deemed proper and is therefore made FINAL.

2. Applicants elected species, and those others of claim 15 are deemed allowable over the art of record.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1-12, 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 teaches "functional material" without defining such material or giving its structure. Since almost every material known to mankind has some functional use, the scope of the material is not clear. Dependent claims fall herewith.

Claim 14 teaches "said organic EL" with reference to claims 1-13, while only claim 13 teaches an organic EL substance.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

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(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 1, 2, 4, 6-10 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Eisenbraun et al. (5006370).

Eisenbraun teaches a composition which comprises a functional material and a solvent containing 1,2,3,4-tetramethylbenzene, xylene and N-methylpyrrolidone (see examples).

Applicants intended use in an inkjet method does not distinguish over the prior art (In re Pearson 181 USPQ 641).

7. Claims 1, 2, 4, 6-8 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Eisenbraun et al. (5068131).

Eisenbraun teaches a composition which comprises a functional material and a solvent containing 1,2,3,4-tetramethylbenzene and N-methylpyrrolidone (see examples). Applicants intended use in an inkjet method does not distinguish over the prior art (In re Pearson 181 USPQ 641).

8. Claims 1, 2, 7, 8 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Takano et al. (5484689).

Takano teaches a composition which comprises a functional material and a solvent containing aromatic agents such as propylbenzene, butylbenzene, hexylbenzene, octylbenzene,

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tetramethylbenzene and cyclohexylbenzene (see examples). Applicants intended use in an inkjet method does not distinguish over the prior art (In re Pearson 181 USPQ 641).

9. Claims 1-3, 17 and 18 rejected under 35 U.S.C. 102(b) as being anticipated by JP 59-71372.

JP '372 teaches a composition comprising a dye and dodecylbenzene which is used as an ink (see pages 2-3). The dye in solvent would act as a color filter.

10. Claims 1 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 64-16880.

JP '880 teaches an ink for use in an inkjet comprising an benzene derivative and a functional material according to the present invention (see pages 7-8).

11. Claims 1, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 04-153280.

JP '280 teaches an ink for an inkjet comprising a dye functional material and a solvent of formula II, which corresponds to the benzene derivative of the present invention. Said dye may be used in a color filter.

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***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 2, 7, 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marlett (4855120).

Marlett teaches a process of producing silane from tetraethoxysilane using solvents within the scope of the present invention, such as diethylbenzene, propylbenzene, propyltoluene and tetramethylbenzenes. The silanes and tetraethylsilane are silica glass precursors. Marlett differs from the present invention in that a specific example of the use of solvents such as diethylbenzene, propylbenzene, propyltoluene and tetramethylbenzenes is not disclosed. It would however, be obvious to one of ordinary skill in the art to utilize solvents such as diethylbenzene, propylbenzene, propyltoluene and tetramethylbenzenes in the invention of Marlett, given the teaching of Marlett that such solvents are useful for producing silane from tetraethylsilane.

14. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. Is 703-872-9311.

PCT-2600  
July 15, 2002



PHILIP C. TUCKER  
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